



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,473	09/17/2003	Carey E. Garibay	ORACL-01454US7	4342
23910	7590	10/21/2009	EXAMINER	
FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108			AGWUMEZIE, CHARLES C	
			ART UNIT	PAPER NUMBER
			3685	
			NOTIFICATION DATE	DELIVERY MODE
			10/21/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OFFICEACTIONS@FDML.COM

Office Action Summary	Application No. 10/664,473	Applicant(s) GARIBAY ET AL.	
	Examiner CHARLES C. AGWUMEZIE	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-129 is/are pending in the application.
- 4a) Of the above claim(s) 19-66, and 68-119, is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 67-76 and 120-129 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>see continuation</u> . | 6) <input type="checkbox"/> Other: _____ |

09/17/03; 03/11/05; 05/26/06; 01/17/07; 08/06/07; 10/31/07; 02/27/08; 05/23/08; 06/19/08; 08/21/08; 09/17/08 and 12/24/08

DETAILED ACTION

Acknowledgment

1. Applicants' amendment filed on June 22, 2009 is acknowledged. Accordingly claims 1-9, 10-18, 67-76, and 120-129, remain pending.

Response to Arguments

2. Applicant's arguments with respect to claims 1-9, 10-18, 67-76, and 120-129 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-8, 10-17, 67-76, and 120-129**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication No.

2004/0039916 A1 in view of Ross et al U.S. patent No. 5,553,143 and in view of Stupek Jr. et al (hereinafter "Stupek") U.S. Patent No. 5,960,189 and further in view of Omshehe et al (hereinafter "Omshehe") U.S. Patent Application Publication No. 2002/0069172 A1.

5. As per **claim 1, 10, 67, and 120**, Aldis et al discloses a method comprising:

maintaining digital records of software licenses, the digital records indicating rights associated with software licenses (0005; 0015; 0121);

upgrading or downgrading the software version for multiple software licenses in a batch mode, an indication of the upgrade or downgrade being stored in the digital record wherein the multiple software licenses are individually selectable (see abstract (see figs. 4 and 5; “license packs”; Aldis teaches that the digital license can be distributed in a license pack. That a license pack contains one or more digital licenses. Arguably a license pack is equivalent to the multiple software licenses in a batch mode as claimed by present invention, see figs. 4 and 5; 0008; 0010; 0011; 0019; 0139; 0070; “license packs”);

6. What Aldis does not explicitly disclose is:

wherein the upgrading or downgrading of the software licenses includes displaying a page that shows current licenses and receiving an indication of what current licenses are selected to upgrade or downgrade, as well as an indication to upgrade or downgrade the selected licenses in the batch mode, the upgrading and downgrading involves providing new license keys for the upgrade/downgrade version, as well as disabling the license keys for the old versions;

wherein the page is a license search result page that displays current licenses found as a result of a search;

wherein the license search page allows for the selection of a group of more than one of the displayed current licenses for upgrading or downgrading in the batch mode, the selection of the group determining which licenses are upgraded or downgraded; and

wherein the upgrading or downgrading is done using at least one processor (see fig. 1).

7. Alternatively Ross et al discloses a method comprising: upgrading or downgrading the software version for multiple software licenses in a batch mode, an indication of the upgrade or downgrade being stored in the digital record (see abstract; col. 1, line 65-col. 2, line 15, which discloses that one or more licenses in a batch of licenses can be enabled to create a software license; col. 30-35; col. 4, lines 25-35; ...a batch of licenses may be anchor or upgrade licenses...);

8. Stupek Jr. et al discloses the method comprising:

wherein the upgrading or downgrading of the software licenses includes displaying a page (window list box 51 is displayed to the user, fig. 6) that shows current licenses to the user (shows current version, fig. 9) and receiving from the user an indication of what current licenses are selected to upgrade or downgrade (see fig. 5A, selectable for upgrade), as well as an indication to upgrade or downgrade the selected licenses in the batch mode (see fig. 5A, can user select this package for upgrading), the upgrading and downgrading involves providing new license keys for the upgrade/downgrade version, as well as disabling the license keys for the old versions (see fig. 5; "can the user select this package for upgrade"; fig. 6, "list box displayed to the user"; see also figs. 9 and 10, installed version 2.30, newest version 2.40; col. 4, lines 45-55, which discloses "when the upgrade advisor 11 and/or user have selected the network resources 3 that need to be upgraded"; see col. 6, line 60-17, which discloses "package can be displayed to the user through a user interface"; col. 9, lines

15-40, which discloses ... display or report upgrade to the user including using color coded visual object...).

9. Omeshehe discloses the method comprising:

wherein the page is a license search result page that displays current licenses found as a result of a search (see fig. 9, which discloses list of active licenses; 0061, which discloses that fig. 9 displays a list of current active concurrent user licenses and their associated user information...displays the current number of installed licenses...)

wherein the license search page allows for the selection of a group of more than one of the displayed current licenses for upgrading or downgrading in the batch mode, the selection of the group determining which licenses are upgraded or downgraded (0046, which discloses that the new license definition is selected...either the new license definition is appended to existing license file on the destination computer, or the new license definition completely replaces (overwrites) that license file; 0047; 0061);

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Aldis et al and incorporate the method wherein the upgrading or downgrading of the software licenses includes displaying a page that shows current licenses and receiving an indication of what current licenses are selected to upgrade or downgrade, as well as an indication to upgrade or downgrade the selected licenses in the batch mode, the upgrading and downgrading involves providing new license keys for the upgrade/downgrade version, as well as disabling the license keys for the old versions; wherein the page is a license search result page that displays current licenses found as a result of a search; wherein the

license search page allows for the selection of a group of more than one of the displayed current licenses for upgrading or downgrading in the batch mode, the selection of the group determining which licenses are upgraded or downgraded; in view of the teachings of Ross, Stupek and Omeshehe respectively in order to ensure that the only the desired licenses are upgraded.

10. As per **claims 2, 11, 68, and 121**, Aldis et al further discloses the method, wherein the upgrading or downgrading of rights is associated with the license key (0019; 0070).

11. As per **claims 3, 12, 69, and 122**, Aldis et al further discloses the method, wherein the digital record is accessed using a web application (see fig. 1; 0065; 0066 0147; “web browser or API”).

12. As per **claims 4, 13, 70, and 123**, Aldis et al further discloses the method, wherein the web application uses role-based security (0005).

13. As per **claims 5, 14, 71, and 124**, Aldis et al further discloses the method, wherein digital records contain configuration information for the computer authorized to run the software (0010; 0072; “...hardware fingerprint of computer requesting activation code...”).

14. As per **claims 6, 15, 72, and 125**, Aldis et al further discloses the method, wherein the digital records can be searched to find a specific digital record (0078; 0121; 0124; "...search and view licenses created...").

15. As per **claims 7, 16, 73, and 126**, Aldis et al further discloses the method, wherein the rights are associated with a license key (0019; 0070).

16. As per **claims 8, 17, 74, and 127**, Aldis et al further discloses the method, wherein configuration information for the computers running the software is stored in the digital record (0010; 0072).

17. As per **claims 76, and 129**, Aldis et al further discloses the method, wherein upgrading or downgrading of the version is done for multiple software licenses in a batch mode (0019; 0070; "license packs").

18. As per **claim 128**, Aldis et al further discloses the method, wherein the license version can also be upgraded (0103).

19. **Claims 9, and 18**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aldis et al U.S. Patent Application Publication No. 2004/0039916 A1 in view of Ross et al U.S. patent No. 5,553,143 and in view of Stupek Jr. et al U.S. Patent No. 5,960,189 and Omshehe et al (hereinafter "Omshehe") U.S. Patent Application

Publication No. 2002/0069172 A1 as applied to claims 1, and 10, above, and further in view of Horstmann U.s. Patent No. 6,009,401.

20. As per claims 9, and 18, Aldis, Ross, Stupek and Erickson failed to explicitly disclose the method, wherein the license version is downgraded.

Horstmann discloses the method, wherein the license version is downgraded (fig. 1; col. 2, line 60-col. 3, line 15).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Aldis et al and incorporate the method, wherein the license version is downgraded as taught by Horstmann in order to ensure availability of various product versions and/or user satisfaction.

Conclusion

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3685

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on **(571) 272 – 6709**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charlie C Agwumezie/
Primary Examiner, Art Unit 3685
October 14, 2009